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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/004,420	01/08/1998	JACOB RICHTER	260048601	1198

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KENYON & KENYON
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NEW YORK, NY 10004

EXAMINER

NASSER, ROBERT L

ART UNIT	PAPER NUMBER
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3736

DATE MAILED: 05/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/004,420

Applicant(s)

RICHTER ET AL.

Examiner

Robert L. Nasser

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 February 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 4, 5, 7-19, 24, 25, 29-37, 39, 40 and 70-84 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 4, 5, 7, 8-19, 24, 25, 29-37, 39, 40, 70-84 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 84 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claim 84 is rejected in that it recites that the device is not configured to touch the body lumen, This recites a positive relationship to the body, which is non-statutory subject matter. As such, the claim is non-statutory. Applicant should recite that the sensor support is adapted not to contact the body lumen when the device is positioned in a vessel, or us similar language.

Before applying art, the examiner notes that the term "sensor support" merely means a surface capable of supporting a sensor. It is the examiner's position that nearly any surface and any shape can support a sensor.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 4, 10-12, 14-18, 70-80, and 82-84 are rejected under 35 U.S.C. 102(b) as being anticipated by Kreamer. Kreamer shows a device having first and second fixation rings, i.e. stents 10 and 12, and a sensor support 14. The sensor support is connected to the end of the fixation device and is located between both fixation devices.

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In addition, element 14 comprises many different areas for supporting a sensor, some that are spaced apart from others, and one that is connected to each fixation device. In addition, with respect to claims 18-18, since the sensor is not part of the claim, the support may be received in a notch like depression or groove or protrusion of the sensor. In addition, the sensor is formed of a different material than the sensor support. With respect to claim 71, the outer stent surface can be considered a sensor support. With respect to claim 84, the device is adapted not to contact the body when not in use.

Claims 10, 13, and 18 are rejected under 35 U.S.C. 102(e) as being anticipated by Campbell et al 6245026. Campbell shows a device including a first, expandable fixation ring, i.e. balloon 125, with first and second sensor supports 38 and 15 on either side of the fixation ring. In addition, in figure 4A, Campbell shows a device with first and second anchoring rings 226, and a sensor support therebetween.

Claims 33 and 39-40 are rejected under 35 U.S.C. 102(e) as being anticipated by Brockway et al 6,379,308. In column 12, lines 11 –30, Brockway teaches a method of fixing a sensor in place by inserting the sensor, i.e. PTC, into a vein and using a sutures or an adhesive to securing the sensor to the vein.

Claims 1, 4, 10-12, 13-19, 24, 25, 29-32, 70-84 are rejected under 35 U.S.C. 102(e) as being anticipated by Cimochocki et al 5967986. Cimochocki et al teaches that it includes a stent graft (like that of Kreamer) with a sensor attached to the graft portion. As such, it has first and second fixation rings, i.e. stents, and a sensor support, i.e. the graft, which has a sensor attached thereon. The sensor support is connected to the end of the fixation device and is located between both fixation devices.

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In addition, the graft comprises many different areas for supporting a sensor, some that are spaced apart from others, and one that is connected to each fixation device. In addition, with respect to claims 16-18, since the sensor is not part of the claim, the support may be received in a notch like depression or groove or protrusion of the sensor. In addition, the sensor is formed of a different material than the sensor support. With respect to claim 71, the outer stent surface can be considered a sensor support. With respect to claim 81, element 220 is a planar support.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 5 and 7-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kreamer in view of Ischinger. Ischinger shows both stents with elliptical and sinusoidal patterns on the external portion of the stent. As such, it would have been obvious to modify Kreamer to use the stent of Ischinger, as it is merely the substitution of one known equivalent stent for another. The exact location to connect the sensor support to the graft 14 would have been a matter of design choice for one skilled in the art.

Claims 5 and 7-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cimoichowski et al in view of Ischinger. Ischinger shows both stents with elliptical and sinusoidal patterns on the external portion of the stent. As such, it would have been obvious to modify Cimoichowski to use the stent of Ischinger, as it is merely the

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substitution of one known equivalent stent for another. The exact location to connect the sensor support to the graft 14 would have been a matter of design choice for one skilled in the art. .

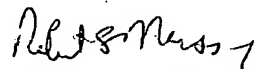
Applicant's arguments filed 2/7/2005 have been fully considered but they are moot in view of the new grounds of rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert L. Nasser whose telephone number is (571) 272-4731. The examiner can normally be reached on Mon-Fri, variable hours.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Max Hindenburg can be reached on (571) 272-4726. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Robert L. Nasser
Primary Examiner
Art Unit 3736



ROBERT L. NASSER
PRIMARY EXAMINER

RLN
May 2, 2005